

### **REMARKS**

The Examiner had indicated in the May 4, 2005 non-final office action, and again in the November 30, 2005 final office that claims 4-6, 21-23 and 38-40 would be allowable if re-written in independent form, including all of the limitations of the base claim and any intervening claims. In both the May 4 and November 30, 2005 office actions, all other pending claims were rejected as being obvious over Kingsford et al., U.S. Patent No. 6,851,161 ("Kingsford") in view of Provost et al., U.S. Patent No. 4,984,339 ("Provost"). In Applicants' response to the final office action, Applicants stated that they did not agree with the Examiner's analysis, but in order to advance issuance of some subject matter amended claims 1, 19 and 37 to include the limitations of claims 4, 21 and 38, respectively. In addition, in the same response, Applicants amended claim 5 to make it dependent from claim 1; amended claim 22 to make it dependent from claim 19; amended claim 39 to make it dependent from claim 37; and cancelled claims 4, 21, 38 and 54. Cancelled claims 4, 21 and 38 each required that the hook component have a stitch hole tear strength of at least 2 pounds.

The Examiner has now withdrawn the allowability of claims having the same scope as originally filed claims 4-6, 21-23 and 38-40 in view of a newly cited reference; namely, Kennedy et al., U.S. Patent No. 6,248,419 ("Kennedy"). All claims are now being rejected as obvious over Kingsford in view of Provost and Kennedy.

In response to the Examiner's withdrawal of allowability, Applicants are amending claims 1, 19 and 37 to remove the recitation of stitch hole tear strength. New claims 55, 56 and 57 have been added, which correspond to cancelled claims 4, 21 and 38, respectively. In addition, Applicants have amended claims 5, 22 and 39 to depend from new claims 55, 56 and 57, respectively. No new matter has been added, as the amendments to the claims and the new claims are fully supported by the originally filed claims.

Applicants respectfully submit that not only are the claims as presented in Applicants' response to the final office action of November 30, 2005 patentable, but so too are the claims as originally filed, as presented again herewith. Applicants request further review by the Examiner in light of the following remarks.

High closure strength is commonly associated with thicker and more bulky woven fastener tapes, and low engaged thickness is generally associated with woven fastener

applications requiring only low closure strength. Applicants have not only realized the need for combining high strength and low thickness in this type of fastener, but have enabled such closures generally through their disclosure. Many of Applicants' thin inventive closures exhibit a high initial peel resistance, a high final peel resistance and/or a high initial shear resistance. In addition, many of Applicants' inventive hook components exhibit a high stitch hole tear strength, enabling closures that can be cycled through a large number of disengagements without the hook component tearing along lines of holes formed during sewing of the closure to a garment, for example.

Independent claims 1, 19 and 37 are each directed to a low profile releasable touch fastener.

Claim 1 requires, in pertinent part, that the touch fastener have a loop component and a hook component configured to releasably engage female fastener elements of the loop component such that the fastener has an engaged thickness of less than about 0.11 inch and a final peel resistance of at least 0.3 pound per inch of closure width.

The Examiner concedes that Kingsford fails to disclose a touch fastener that has hook and loop components provided with a final peel resistance of at least 0.3 pounds per inch of closure width (page 3 of the office action). However, the Examiner contends that Provost provides hook and loop components that provide a final peel resistance of at least 0.3 pounds per inch of closure width.

Applicants respectfully submit that they are not asserting that low profile closures are new, nor are they asserting that closures exhibiting a high final peel resistance are new; rather, Applicants are asserting that low profile closures having an engaged thickness of less than about 0.11 inch *in combination* with a final peel resistance of at least 0.3 pound per inch of closure width are new and non-obvious, particularly over Kingsford in view of either Provost alone, or of Provost and Kennedy. Just because Provost's hooks can provide high peel and/or shear resistance under certain circumstances does not mean that applying Provost's hooks to Kingsford's low profile would result in a low profile closure exhibiting high peel and/or shear resistance. Applicants note that Provost does not even describe the type of loop material used in his closures, nor is it clear that the peel data disclosed by Provost corresponds to either Initial Peel Resistance or Final Peel Resistance, as used in Applicants' claims. It would appear that

Table III of Provost is simply used to show relative rankings of how particular hooks perform when used with a certain type of loop material. Importantly, Provost does not disclose or suggest that his hooks can be used as part of a low profile closure, and discloses nothing of overall closure thickness. Kingsford discloses a thin rib-and-groove sealing closure with hook and loop fastener elements. Kingsford describes that using the hook and loop fasteners elements in combination with a seal can be advantageous in that engagement of the hook and loop elements reduce the likelihood of unwanted opening of the closure (see, e.g., col. 4, lines 15-33), but Kingsford does not disclose that they need to form a particularly strong closure to perform their function, and discloses nothing about peel strength.

Nor does Kennedy, cited with respect to the stitch hole tear strength claim limitation for disclosing a reinforced hook fastener component, provide any teaching to overcome the above deficiency of the Kingsford-Provost combination with respect to claim 1. As with the Provost reference, Kennedy does not disclose a loop component, and therefore does not disclose any overall closure thickness.

Given the above amendment, Applicants understand the Examiner's citation of Kennedy to now pertain specifically to claims 5 and 55, as depending directly or indirectly from claim 1 and reciting a specific stitch hole tear strength. While Applicants maintain that these dependent claims are allowable at least as depending from allowable base claims, Applicants now address the citation of Kennedy as against their claims reciting, in combination with other features, particular stitch hole tear strength. At page 7 of the office action, the Examiner concedes that Kennedy fails to disclose a hook component having a stitch hole tear strength of at least 2.0 pounds or at least 5.0 pounds. However, the Examiner asserts that because Kennedy discloses a fabric sheet laminated to the hook component, such a component is *capable* of having such a stitch hole tear strength. Applicants take these statements to mean either that the Examiner believes that those hook components disclosed by Kennedy would *inherently* have a stitch hole tear strength of at least 2.0 pounds or 5.0 pounds, or that one of ordinary skill in the art would otherwise have been led by Kennedy to provide a fastener having such a stitch hole tear strength. Applicants do not agree as to either assertion. In relying on inherency, the Examiner would be under the burden to show that the inherency *necessarily* flows from the disclosure of the reference used to reject the claims. For example, it is not enough to show that a certain result

may occur or is *capable* of occurring (see MPEP 2112; In re Rijckaert, 9 F.3d 1531; and Ex parte Levy, 17 USPQ2d 1464); rather, the Examiner is under the burden of showing that the result is *necessarily* occurring. As to whether one of ordinary skill would have been motivated by Kennedy to provide a proposed Kingsford-Provost combination product with a particular stitch hole tear strength, the Examiner has failed to identify any particular teaching or aspect of Kennedy that would have motivated one of ordinary skill to not only provide a scrim to a molded fastener, but to specifically reinforce a fastener product in such a way that a particular stitch hole tear strength is obtained.

Applicants respectfully submit that in citing Kingsford and Provost, the Examiner has simply gone out to the prior art and found a low profile closure (Kingsford) and a hook that can provide high shear and peel resistance when mated with certain loop materials (Provost), and asserted that since they are both known, it would have been obvious to combine the two. However, this is not proper since obviousness cannot be established by simply stitching together independent pieces of prior art using the Applicant's application as a template (see, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132; Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861; and In re Fine, 837 F.2d 1071). Applicants' claims are not disjointed lists of elements, but present an invention that must be considered *as a whole* (see, e.g., MPEP 2141.02; and Stratoflex, Inc. v. Aeroquip, 713 F.2d 1530). While the cited references may include a low-profile fastener and a high peel fastener, the combination of the Kingsford and Provost creates absolutely no understanding of how one of ordinary skill might go about creating a fastener that is both low in profile and has a high peel strength. Rather, it is Applicants' teachings that have enabled the claimed product. Applicants therefore respectfully submit that claim 1, and all claims that depend therefrom, are non-obvious over Kingsford in view of Provost, or in view of Provost and Kennedy.

Claim 19 requires, in pertinent part, that the touch fastener have a loop component and a hook component configured to releasably engage female fastener elements of the loop component such that the fastener has an engaged thickness of less than about 0.11 inch and an initial peel resistance of at least 0.5 pounds per inch of closure width. While claim 1 featured a combination of thinness and *final* peel resistance, claim 19 features a combination of thinness and *initial* peel resistance.

Regarding claim 19, the Examiner contends at page 6 of the office action that a combination of rejections of claims 1 and 2 (claim 2 depending from claim 1 and featuring initial peel resistance) will result in the limitations of claim 19. It is clear from even the form of this rejection that the Examiner is not considering the claimed invention holistically. Rather, the Examiner is attempting to reconstruct the claimed invention by stitching together independent pieces of prior art using Applicants' claims as a list of ingredients needed to reject the claims. As discussed above, this is an improper view of the test of patentability. Applicants respectfully submit that claim 19, and its dependent claims are non-obvious over Kingsford in view of Provost, or of Provost and Kennedy, for at least the reason that neither cited combination of references suggests nor enables a low profile closure having an engaged thickness of less than about 0.11 inch in combination with an initial peel resistance of at least 0.5 pounds per inch of closure width.

Claim 37 requires, in pertinent part, that the touch fastener have a loop component and a hook component configured to releasably engage female fastener elements of the loop component such that the touch fastener has an engaged thickness of less than about 0.11 inch and an initial *shear* resistance of at least 10 pounds per square inch.

Regarding claim 37, the Examiner contends at page 6 of the office action that a combination of rejections of claims 1 and 3 (claim 3 requiring that the hook and loop components are so configured to provide an initial shear resistance of at least 10 pounds per square inch) will result in the limitations of claim 37. Again, it is clear from the form of this rejection that the Examiner is not considering the claimed invention as a whole. Applicants submit that claim 37 and its dependent claims are non-obvious over Kingsford in view of Provost, or of Provost and Kennedy, for at least the reason that neither cited combination of references suggests nor enables a low profile closure having an engaged thickness of less than about 0.11 inch in combination with an initial shear resistance of at least 10 pounds per square inch.

Applicants respectfully submit that all claims are non-obvious over Kingsford in view of Provost, or in view of both Provost and Kennedy, for at least the reasons outlined above, and respectfully request a Notice of Allowance.

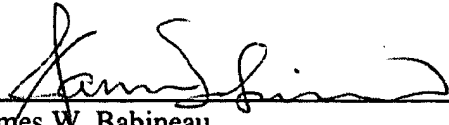
Applicants: Nancy J. Tolan et al.  
Serial No. : 10/688,032  
Filed : October 15, 2003  
Page : 15 of 15

Attorney Docket No.: 05918-322001 / VGCP No. 5080

Enclosed is a check for \$120.00 for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 05918-322001.

Respectfully submitted,

Date: May 10, 2006

  
\_\_\_\_\_  
James W. Babineau  
Reg. No. 42,276

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

21327680.doc